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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,220	04/11/2001	Sergey Dorofeev	MORGCAS00NPA	1674

7590 11/04/2004  
Max Stul Oppenheimer  
P.O. Box 50  
Stevenson, MD 21153

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/833,220

Applicant(s)

DOROFEEV ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

### **DETAILED ACTION**

1. Claim 1 is presented for examination.

#### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required.

#### ***Specification***

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required. Furthermore, Applicant's incorporation of an abstract by reference is improper.

4. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory

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material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

The attempt to incorporate subject matter into this application by reference to various non-patent publications is improper because these publications appear to contain all of the essential subject matter describing Applicant's invention.

### ***Drawings***

5. There are no drawings. The drawings must show every feature of the invention specified in the claims.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of

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the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The understanding of “casualness” is critical or essential to the practice of the invention; however, the specification does not explain what “casualness” is, how it is determined, how it is useful, etc.

8. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The understanding of “casualness” is critical or essential to the practice of the invention; however, the specification does not explain what “casualness” is, how it is determined, how it is useful, etc.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what "casualness" is, how it is determined, how it is useful, etc., thereby rendering the claim vague and indefinite.

***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 does not produce a useful, concrete, and tangible result (especially since the specification does not explain what "casualness" is or what usefulness it produces). Furthermore, claim 1 does not incorporate the technological arts.

Appropriate correction is required.

*The following art rejection reflects the Examiner's best understanding of the claimed invention. The art rejection refers to Applicant's cited "Memorandum from Sergey Dorofeev to Gary Morgan, et al., Re: Casualness without COT" for the admitted prior art disclosed by the reference.*

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's cited "Memorandum from Sergey Dorofeev to Gary Morgan, et al., Re: Casualness without COT" in view of Applicant's cited article by Christopher Fry ("The Accumulation of Audiences for Australian Publications").

On page 1 of the "Memorandum from Sergey Dorofeev to Gary Morgan, et al., Re: Casualness without COT," co-applicant Sergey Dorofeev discloses that the determination of casualness based on recency and frequency is old and well-known (i.e., admitted prior art). Sergey Dorofeev proposes an improvement to this existing casualness calculation. "The proposal is to change the frequency question in the diary: instead of four time periods (four weeks or four months) ask how many issues a respondent read in the last *two* time periods (two weeks or two months)." (Page 1) Four advantages to this change in frequency are outlined on pages 1 and 2. Advantage number four expressly states, "The two-occasion or two-period measure corresponds to the way we (and Simmons) have traditionally measured casualness by re-interview" (Page 2). Fry establishes that re-interviews consisting of "two or more interviews" are old and well-known (see at least page 10 of Fry). Clearly, the frequency of re-interviews is established by the person(s) in charge of the re-interviews. For example, re-

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interviews directed toward publications that only printed twice a year may only be capable of two annual re-interviews as opposed to publications that are printed four or more times a year. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the existing casualness calculation to change the frequency from four time periods to two time periods to address publications that are not published as frequently, e.g., twice a year as opposed to four times a year.

### ***Conclusion***

15. This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.



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Any response to this action should be mailed to:

**Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450**

or faxed to:

**(703)872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703)746-7048** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7<sup>th</sup> floor receptionist.



Susanna M. Diaz  
Primary Examiner  
Art Unit 3623  
November 1, 2004

Continuation of Attachment(s) 6). Other: Requirement for Information under 37 CFR 1.105.

**37 CFR § 1.105 - Requirement for Information**

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

In Applicant's cited "Memorandum from Sergey Dorofeev to Gary Morgan, et al., Re: Casualness without COT," Sergey Dorofeev states that he proposes to change the frequency associated with the casualness calculation from four time periods to two. Examiner requests clarification regarding any prior art methods of determining casualness. Furthermore, Applicant should explain what improvements the claimed invention provides over the existing prior art methods (including those disclosed by George Rennie and Christopher Fry, as cited in the bibliography of the memorandum). When was Applicant's claimed invention first publicly disclosed, sold, and/or used?

On page 2 of Applicant's cited "Memorandum from Sergey Dorofeev to Gary Morgan, et al., Re: Casualness without COT," reference is made to Simmons in the discussion of the advantages of using a frequency of two instead of four. Sergey Dorofeev proposes an improvement to this existing casualness calculation. "The proposal is to change the frequency question in the diary: instead of four time periods (four weeks or four months) ask how many issues a respondent read in the last *two* time periods (two weeks or two months)." (Page 1) Four advantages to this change in frequency are outlined on pages 1 and 2. Advantage number four expressly states, "The two-occasion or two-period measure corresponds to the way we (and Simmons) have traditionally measured casualness by re-interview" (Page 2). Simmons is not

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listed as an inventor. Who is Simmons? What contribution has Simmons made to the concepts of casualness and/or utilizing a frequency of two instead of four? When were these contributions made? Please provide any documents authored by Simmons regarding these topics. Also, does Applicant's statement that the "two-occasion or two-period measure corresponds to the way we (and Simmons) have *traditionally* measured casualness by re-interview" (*emphasis added*) imply that such a practice is old and well-known (i.e., admitted prior art)?

2. The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

3. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

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4. This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

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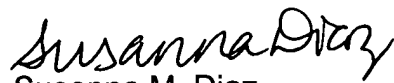
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Susanna M. Diaz  
Primary Examiner  
Art Unit 3623  
November 1, 2004



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 0000